



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/168,585	10/08/98	DAVIS	F 0001-001(B)

ROBERT G LEV
4766 MICHIGAN BOULEVARD
YOUNGSTOWN OH 44505

MM91/0815

EXAMINER

SHAHER, R

ART UNIT	PAPER NUMBER
----------	--------------

2872

DATE MAILED:

08/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/168,583

Applicant(s)

DANES ET AL

Examiner

R.D. SHAFER

Group Art Unit

2872

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 4/14/00
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 80-82 AND 87-91 is/are pending in the application.
- Of the above claim(s) 80-82, 87 AND 88 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 89-91 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 2872

1. Applicant's election without traverse of invention II (claims 89-91) in Paper No. 11 is acknowledged.
2. Claims 80-82, 87 and 88 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 11.
3. The petition to correct the inventorship of this nonprovisional application under 37 CFR 1.48(a) is deficient because it lacks the required fee under 37 CFR 1.17(h).
4. The terminal disclaimer filed on 10/08/98 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent 5,262,879 has been reviewed and is NOT accepted.
 - a). The disclaimer fee of \$55.00 in accordance with 37 CFR 1.20(d) has not been submitted, nor is there any authorization in the application file to charge a Deposit Account.
 - b). The application/patent which forms the basis for the double patenting rejection is not identified in the terminal disclaimer.
5. Claim 91 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 91, line 3, "said image" is confusing. It is unclear whether the above mentioned language is referring to said image data or to some other image.

Art Unit: 2872

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(f) he did not himself invent the subject matter sought to be patented.

7. Claims 89-91 are rejected under 35 U.S.C. 102(f) as being clearly anticipated by Davis ('879) and Davis ('092).

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 89-91 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 12 and 16 of U.S. Patent No. 5,262,879. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application (09/168,585) discloses no additional invention or discovery other than what was already claimed and patented in U.S. Patent 5,262,879 or what would have been obvious to one of ordinary skill in the art at the time the invention was made.

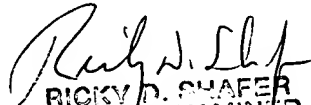
Art Unit: 2872

10. Claims 89-91 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 5,822,092. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application (09/168,585) discloses no additional invention or discovery other than what was already claimed and patented in U.S. Patent 5,822,092 or what would have been obvious to one of ordinary skill in the art at the time the invention was made.

11. Any inquiry concerning this communication should be directed to R.D. Shafer at telephone number (703) 308-4813.

Shafer/TR

08-04-00


RICKY D. SHAFER
PATENT ENGINEER
ART UNIT 2872